

Application Serial No.: 09/847,395
Reply to Office Action dated June 4, 2004

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1, 3, 7, and 11-19 are presently active in this case, Claims 1, 3, 7, and 11 having been amended by way of the present Amendment. Claims 2, 4-6, and 8-10 have been canceled without prejudice or disclaimer from the present application.

The Applicants respectfully submit that the amendment to Claims 1, 3, 7, and 11 in the Amendment filed on March 15, 2004, in which subject matter related to a reference critical energy value of PVB film was deleted from Claims 1, 3, 7, and 11 and added to new Claims 14-17 has support in the originally filed specification. The specification provides support for the broader reference critical energy value, for example, in paragraph 0044 on page 9 and in paragraph 0049 on page 10. The specification describes exemplary embodiments that are not meant to limit the scope of the claims in any way. The Applicants are not required to describe all possible embodiments of their invention in the specification. The specification makes clear that the use of PVB film as the reference film is an exemplary embodiment in paragraph 0044 on page 9. Thus, the specification supports broadly reciting the reference critical energy value, as recited in Claims 1, 3, 7, and 11.

In the outstanding Official Action, Claims 1, 3, 7, 11, and 14-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over the '615 Rehfeld patent (U.S. Patent No. 5,478,615). Claims 1, 7, and 12-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Friedman et al. (U.S. Patent No. 5,908,704) in view of Hamdi et al. (U.S.

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Patent No. 5,598,669) as evidenced by EP 0 100 701. For the reasons discussed below, the Applicants request the withdrawal of the obviousness rejections.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants submit that a *prima facie* case of obviousness has cannot be established in the present case because the references, either taken singularly or in combination, do not teach or suggest all of the claim limitations recite in independent Claims 1, 3, 7, and 11.

Claims 1, 3, 7, and 11 of the present application recite, among other features, a polymer film for use as an intermediate layer of a glazing material where the intermediate layer primarily satisfies acoustic property criteria defined in a specified manner, and secondarily satisfies mechanical strength criteria based upon tearing resistance characteristics defined in a specified manner.

The Rehfeld et al. reference describes an acoustic protective glazing for a vehicle. The Official Action indicates that the Rehfeld et al. reference describes an interlayer having certain mechanical properties, and cites column 2, lines 55-57 of the Rehfeld et al. reference for such a teaching. However, the Applicants submit that the Rehfeld et al. reference does not disclose an intermediate layer that satisfies mechanical strength criteria. The Rehfeld et al. reference merely describes the selection of the material based upon acoustic criteria. Column

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2, lines 55-57 of the Rehfeld et al. reference does not discuss mechanical properties of the interlayer, but rather noise generating features of land vehicles. Furthermore, the Rehfeld et al. reference clearly does not disclose an intermediate layer that satisfies mechanical strength criteria *based upon tearing resistance characteristics*, as specified in the claims of the present application.

Accordingly, the Applicants respectfully request the withdrawal of the obviousness rejection of Claims 1, 3, 7, and 11 in view of the Rehfeld et al. reference.

Regarding the rejection of Claims 1 and 7 in view of the Friedman et al. reference in view of the Hamdi et al. reference and the EP 0 100 701 reference, the Applicants submit that the references do not teach or suggest a polymer film for use as an intermediate layer of a glazing material where the intermediate layer primarily satisfies acoustic property criteria defined in a specified manner, and secondarily satisfies mechanical strength criteria based upon tearing resistance characteristics defined in a specified manner. Furthermore, the Applicants submit that the combination of the above references to arrive at the present invention requires the use of hindsight considerations in view of the present invention, which is improper.

The Friedman et al. reference is cited for the teaching of an interlayer film for protective glazing laminates. As noted in the Official Action, the Friedman et al. reference does not disclose the acoustic property criteria of the intermediate layer. Furthermore, the Friedman et al. describes a protective glazing that focuses on the heat resistance of the film. (See, e.g., column 2, line 20.) The Friedman et al. reference does not disclose a film that

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satisfies mechanical strength criteria based upon tearing resistance characteristics defined in the manner set forth in Claims 1 and 7 of the present application.

The Applicants further submit that the Hamdi reference and the EP 0 100 701 reference do not teach or suggest a film that satisfies mechanical strength criteria based upon tearing resistance characteristics defined in the manner set forth in Claims 1 and 7 of the present application. Thus, a *prima facie* case of obviousness cannot be established with respect to Claims 1 and 7 in view of the cited references.

Furthermore, none of the cited references teach or suggest a film that satisfies a combination of a primary acoustic property criteria and a secondary mechanical strength criteria. The Applicants respectfully submit that the rejection is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicant's structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Accordingly, the Applicants respectfully request the withdrawal of the obviousness rejection of Claims 1 and 7 based upon the combination of the Friedman et al. reference, the Hamdi et al. reference, and the EP 0100 701 reference.

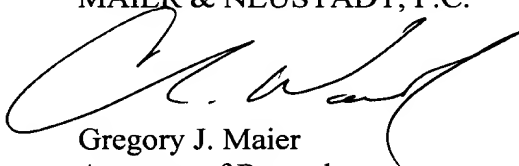
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Claims 12-19 are considered allowable for the reasons advanced for Claims 1, 3, 7, and 11 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claims 1, 3, 7, and 11.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully submitted,

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